

### **REMARKS**

Claims 6, 17 and 19-111 are pending upon entry of the amendments above. Claims 1 to 5, 7 to 16 and 18 have been cancelled without prejudice or disclaimer and Applicants reserve the right to pursue the subject matter of these claims in related applications.

Claims 21-111 have been added to expand the embodiments of the provisionally elected group (see below). New claims 21-111 are completely supported by the specification as originally filed. Specifically, support for the newly filed independent claims 21, 35, 44, 66, 78, 88, 95 and 102, as well as dependent claims 22-29, 36-38, 45-60, 67-72, 79-82, 89, 96 and 103-106, can be found in the application as originally filed, for example, at paragraphs [0014]-[0016], [0018], [0086], [0088]-[0097], [0098]-[0099], [0108]-[0116] and [0121]. Furthermore, support for newly added dependent claims 30-31, 39-40, 61-62, 73-74, 83-84, 90-91, 97-98 and 107-108 may be found, for example, at paragraph [0124]; support for newly added dependent claims 32, 41, 63, 75, 85, 92, 99 and 109 may be found, for example, at paragraph [0085]; support for newly added dependent claims 33, 42, 64, 76, 86, 93, 100 and 110 may be found, for example, at paragraphs [0078]-[0085]; and support for newly added dependent claims 34, 43, 65, 77, 87, 94, 101 and 111 may be found, for example, at paragraphs [0147]-[0149].

Accordingly, no new matter has been introduced.

### **Restriction Requirement**

The Examiner has required an election under 35 U.S.C. § 121 of one of the following groups:

- I. Claims 1-12 drawn to a polynucleotide encoding chemokine  $\beta$ -6, a recombinant vector, a method for making a recombinant vector, a recombinant host cell, a method for making a recombinant host cell and a method for producing a chemokine  $\beta$ -6 polypeptide, classified in class 435, subclass 69.5.

- II Claim 13-16, 18, drawn to a chemokine  $\beta$ -6 polypeptide and a pharmaceutical composition thereto, classified in class 530, subclass 324.
- III Claim 17, drawn to an antibody that binds chemokine  $\beta$ -6 polypeptide classified in class 530, subclass 387.9.
- IV Claim 19, drawn to a method of treatment with chemokine  $\beta$ -6 polypeptide, classified in class 424, subclass 85.1.
- V Claim 20, drawn to a method of diagnosing an immune system disorder by determining the level of expression of chemokine  $\beta$ -6 polypeptide, classified in class 435, subclass 7.1.

See, Paper No. 8122004, page 1. The Examiner contends that the inventions are distinct, each from the other.

Preliminarily, Applicants note that the present application is directed to chemokine alpha-6, not beta-6. Applicants presume that the Examiner's recitation of beta-6 is inadvertent, and respond herein as if the Examiner had instead recited alpha-6.

In order to be fully responsive, Applicants provisionally elect, *with traverse*, the subject matter of group II as represented by originally filed claims 13-16 and 18, and drawn to chemokine alpha-6 ( $\alpha$ -6) polypeptides and related composition, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Additionally, should the present restriction requirement be made final, Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Applicants point out that claims 1-5, 7-16 and 18 have been canceled, and that new claims 21 to 111 are directed to subject matter falling within the ambit of group II as cast by the Examiner.

Applicants respectfully traverse and request the withdrawal of the Restriction Requirement.

As a threshold matter, Applicants point out that M.P.E.P. § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." See M.P.E.P. § 803.

In the present situation, no such showing has been made. Although the Examiner has argued that groups I through V are distinct, Applicants nonetheless submit that a search of the claims of group I would also provide useful information for the claims of groups II through V, while a search of the claims of group II would also provide useful information for the claims of groups I and III through V. For example, in many if not most publications disclosing a polynucleotide, the authors also routinely include polypeptides encoded thereby as well as antibodies that bind such polypeptides. Since the searches for polynucleotides, polypeptides and antibodies commonly overlap, the search and examination of a polynucleotide and the corresponding polypeptides as well as antibodies it binds, would not entail a serious burden.

Accordingly, in view of M.P.E.P. § 803, the claims of all groups I-V should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the instant claims be examined in one application.

Applicants respectfully request that the above-made amendments and remarks be entered and made of record in the file history of the instant application.

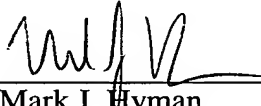
**Conclusion**

In view of the foregoing remarks, Applicants believe that this application is now in condition for substantive examination. The Examiner is invited to call the undersigned at the phone number provided below if any further action by applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Enclosures  
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